

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/109,830
Filing Date July 2, 1998
Inventor John P. Kennelly et al.
Assignee John P. Kennelly
Group Art Unit 3724
Examiner C. Dexter
Attorney's Docket No. KE27-001
Title: Cutting Table Fence





RESPONSE TO RESTRICTION REQUIREMENT

To: Assistant Commissioner for Patents
Washington, D.C. 20231

From: James L. Price (Tel. 509-624-4276; Fax 509-838-3424)
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Responsive to the restriction/election requirement mailed 09/20/99, applicant provisionally elects Group I (claims 1, 2, 3, 11, 4, 7-9, 10, 12 and 15-17) with traverse as noted below.

It is submitted that the restriction requirement is improper per se. It is noted that claims 1, 2, 3 and 11 are included in each of the four groups. It is then stated that the claims of Group I and II, Groups I and III, Groups I and IV, Groups II and III, Groups II and IV, and Groups III and V are separate inventions. However, the individual groups include the same claims. Claim 1, for example, in Group I cannot logically be said to be patentably distinguishable from claim 1 in

1 Group II. This is likewise true of the remaining claims common to each
2 of the four enumerated groups.

3 It is stated in paragraphs 5-10 that the various groups, in various
4 combinations, are separate inventions. It is stated that the inventions
5 in these groups are distinct. There is no indication in the Action
6 regarding distinct species but rather distinct "inventions." Applicant must
7 therefore assume that the action is an election requirement requiring an
8 election of one in the four enumerated inventions. It is submitted that,
9 for the above reasons, this is improper and does not meet *prima facie*
10 requirements for a restriction requirement.

11 It is further submitted that election and species restriction
12 requirements are discretionary within the Patent and Trademark Office.
13 Applicant has submitted claims that are closely related in a specific field
14 (cutting table fences), has not exceeded the number of claims allowed
15 for payment of the filing fee, and has not exceeded the number of
16 independent claims allowed for the payment of the filing fee. Thus, the
17 Applicant should be entitled to examination on the merits of the claims
18 as presented. This should not create an undue burden on the Patent
19 and Trademark Office. On the other hand, division of this application
20 into four separate applications would create a severe burden on the
21 Applicant in terms of preparation fees, filing fees, issue fees and
22 maintenance fees.

It is urgently requested that the election/restriction requirement be withdrawn and that action on the merits of all claims in this application be issued.

If the Examiner wishes to discuss these issues further, a telephone interview is invited.

Respectfully submitted,

Dated: 11/17/99

By: James L. Price
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